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OFFICE OF PETITIONS

In re Patent No. 7,456,219
Miller et al.
Issue Date: November 25, 2008
Application No. 10/600,132
Filed: June 19, 2003
Attorney Docket No. 24852-501 CIP

: DECISION ON REQUEST FOR
: RECONSIDERATION OF
: PATENT TERM ADJUSTMENT
: AND NOTICE OF INTENT TO ISSUE
: CERTIFICATE OF CORRECTION

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d) filed December 16, 2008. Patentees request that the determination of patent term adjustment for the above-identified patent be corrected from one thousand three hundred fifty-one (1,351) days to one thousand four hundred sixty-eight (1,468) days.

The request for reconsideration of the patent term adjustment indicated in the patent is GRANTED to the extent indicated herein.

Patentees are given THIRTY (30) DAYS or ONE (1) MONTH, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under 37 CFR 1.136.

The patent term adjustment indicated on the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of 795 days.

On November 25, 2008, the above-identified application matured into U.S. Patent No. 7,456,219 with a revised patent term adjustment of 1,351 days. On December 16, 2008, patentees timely submitted this request for reconsideration of patent term adjustment within two months of the issue date of the patent. See 37 CFR 1.705(d).

Patentees dispute the reductions of period of adjustment of the patent term¹ by 48 days for the filing of the "Communication" on August 1, 2008, and by 21 days for the filing of an Information Disclosure Statement (IDS) on September 18, 2008. Patentees aver that the correct number of days of patent term adjustment is 1,468 days in view of the disputed periods of reduction, as well as the court's interpretation of the overlap provision as set forth in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentees assert that pursuant to Wyeth, a PTO delay under 35 U.S.C. 154(b)(1)(A) overlaps with a delay under 35 U.S.C. 154(b)(1)(B) only if the delays "occur on the same day." Patentees contend that the periods of delay attributable to grounds specified under 35 U.S.C. 154(b)(1)(A) and 35 U.S.C. 154(b)(1)(B) overlap by 26 days as they occur on the same days in both periods. Patentees maintain: "The adjustment sought under 37 C.F.R. § 1.703(f) is the sum of the periods under § 1.702(a) (578 days) and § 1.702(b) (890 days), less the additional delays attributable to Applicant (0 days)." *Application filed 12/16/08, pp. 2-3.* "Accordingly, Applicant respectfully requests an adjustment of patent term under § 1.703(f) to indicate a total PTA of 1,468 days." Id.

At the outset, it has been determined that due to USPTO clerical error, at the time of the mailing of the notice of allowance, a period of adjustment 604 days associated with "RECORD A PETITION DECISION OF GRANTED FOR PATENT TERM ADJUSTMENT AFTER ALLOWANCE" was erroneously entered. Thus, the period of adjustment of 604 days is being removed.

With regard to the period of reduction of 48 days under 37 CFR 1.704(c)(10), a review of the application history reveals that the patent term adjustment was reduced for the submission of a "Miscellaneous Incoming Letter" received in the Office on August 1, 2008. The record confirms that patentees filed a "Communication" under their duty of candor and good faith to the Office. A Letter of Candor and Good Faith is not a paper for which its filing is considered a "failure to engage in

¹ Patentees mistakenly stated that the period of adjustment of the patent term was reduced by 21 days for the filing of the "Communication" and by 48 days for the filing of the IDS.

"reasonable efforts" within the meaning of 37 CFR 1.704(c)(10).² Thus, it is concluded that the reduction of 48 days is not warranted and will be removed.

With regard to the period of reduction of 21 days under 37 CFR 1.704(c)(10) for the filing of the IDS on September 18, 2008, patentees argue that the reduction is in error because the IDS was filed within 30 days of receipt of the information in the IDS from a foreign patent office.

Pursuant to 37 CFR 1.704(d):

A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

It is undisputed that patentees filed the IDS on September 18, 2008, after the mailing of the notice of allowance. A review of the IDS filed September 18, 2008, reveals that it did not include the proper statement under 1.704(d). Specifically, the IDS was accompanied by the following statement:

² Pursuant to 37 CFR 1.704(c)(10):

Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

- (i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or
- (ii) Four months;

Applicants hereby certify, as specified in 37 C.F.R. §1.97(e), that the item of information contained in this Supplemental Information Disclosure Statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than thirty (30) days prior to the filing of this Supplemental Statement.

Emphasis added.

However, the statement required under 37 CFR 1.704(d) must state that:

[E]ach item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

Emphasis added.

The statement accompanying the IDS filed September 18, 2008, does not contain the language required by 37 CFR 1.704(d). Accordingly, it is concluded that the period of reduction of 21 days is merited and will remain.

As to patentees' interpretation of the period of overlap, the Office finds that it is inconsistent with the Office's interpretation of the overlap provision, 35 U.S.C. 154(b)(2)(A). 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

to the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f)³ and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 54366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

Further, as stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the

³ Likewise, 37 CFR 1.703(f) provides that:

To the extent that periods of delay attributable to the grounds specified in § 1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding § 1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the period during which the application was pending before the Office beginning on the date of filing of the application under 35 U.S.C. 111(a) on June 19, 2003, and ending on the date of issuance of the patent on November 25, 2008, (not including any other periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)).

Pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1), (2), and (4),⁴ 821 days⁵ of patent term adjustment were accorded

⁴ 37 CFR 1.702, provides grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 (original applications, other than designs, filed on or after May 29, 2000).

- (a) Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:
- (1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application;
 - (2) Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken[.]

during the pendency of the application for Office delay prior to the issuance of the patent. Pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b),⁶ 890 days of patent term adjustment accrued for Office issuance of the patent more than three years after the filing date of the application.

All of the 890 days of patent term adjustment under 37 CFR 1.702(b) overlap with the 821 days of patent term adjustment under 37 CFR 1.702(a)(1), (2) and (4). Entry of both the 890 days and the 821 days is neither permitted nor warranted. 890 days is the actual number of days issuance of the patent was delayed.

Accordingly, at issuance, the Office properly entered 69 additional days of patent term adjustment for the Office taking

(4) Issue a patent not later than four months after the date on which the issue fee was paid under 35 U.S.C. 151 and all outstanding requirements were satisfied[.]

⁵ The Office mailed a Restriction Requirement on June 2, 2006, 14 months and 652 days after the application was filed on June 19, 2003. Additionally, the Office did not respond to the reply of July 16, 2007, until December 12, 2007, 4 months and 26 days after the date on which the reply was filed. Lastly, the Office issued the patent on November 25, 2008, four months and 143 days after the payment of the issue fee.

⁶ Pursuant to 35 U.S.C. 154(b)(1)(B), 37 CFR 1.702(b) provides:

Failure to issue a patent within three years of the actual filing date of the application. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including:

- (1) Any time consumed by continued examination of the application under 35 U.S.C. 132(b);
- (2) Any time consumed by an interference proceeding under 35 U.S.C. 135(a);
- (3) Any time consumed by the imposition of a secrecy order under 35 U.S.C. 181;
- (4) Any time consumed by review by the Board of Patent Appeals and Interferences or a Federal court; or
- (5) Any delay in the processing of the application by the Office that was requested by the applicant.

in excess of three years to issue the patent, for a total Office delay of 890 days.

In view thereof, the revised determination of patent term adjustment at the time of the issuance of the patent should be 795 days (890 (652+26+143+69) days of Office delay - 95 (31+32+8+3+21) days of applicant delay).

The Office acknowledges the submission of the \$200.00 fee under 37 CFR 1.18(e).

This matter is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by 795 days.

Telephone inquiries regarding this matter should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

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Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

DRAFT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 7,456,219 B2

DATED : Nov. 25, 2008

INVENTOR(S) : Miller et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (1351) days

Delete the phrase "by 1351 days" and insert -- by 795 days--